

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problem Mailbox.**

PR4



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,737	06/12/2001	Martin Burgess	1870.00002	9542

21615 7590 07/02/2004

CHRISTOPHER P. MAIORANA, P.C.  
 24840 HARPER  
 ST. CLAIR SHORES, MI 48080

EXAMINER
----------

BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/879,737

Applicant(s)

BURGESS ET AL.

Examiner

Adam L Basehoar

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03/29/02 12/12/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: The application filed on 06/12/01 which claims foreign priority from foreign application number 0101297.0 filed in the United Kingdom on 01/17/01 as well as the two IDS filed on 12/12/01 and 03/29/02 respectively.

2. Claims 1-9 are pending in the case. Claims 1 and 9 are independent claims.

#### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on 01/17/01. It is noted, however, that applicant has not filed a certified copy of the 0101297.0 application as required by 35 U.S.C. 119(b).

#### ***Specification***

4. The disclosure is objected to because of the following informalities: The arrangement of the Specification is objected too for not being in the proper format. Please note the suggested arrangement below.

Appropriate correction is required.

5. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Art Unit: 2178

### **Arrangement of the Specification**

6. As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Objections***

7. Claims 1 and 8 are objected to because of the following informalities: On line 4 of page 7, claim 1 reads "date to a file," but should read "data to a file." On line 18 of page 9, claim 8 reads "handwritten date," but should read "handwritten data." Appropriate correction is required.

Art Unit: 2178

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The terms "substantially immediately," page 8, line 4, in claim 6 and "more rigorous," page 8, line 19, in claim 8, are relative terms which render the claims indefinite. The term "substantially immediately" and "more rigorous" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

11. Regarding claim 8, the phrases contained in parentheses constitute "for example" like limitations and render the claim indefinite because it is unclear whether the limitation(s) within the parentheses are part of the claimed invention. Said phrases begin on page 8, lines 17 & 22, and page 9, lines 3, 6, 8, 18, 20, 23, 24, and 27. See MPEP § 2173.05(d).

Art Unit: 2178

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-4 and 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Smithies et al (US: 6,381,344 04/30/02).

-In regard to independent claims 1 and 9, Smithies et al teach a method and apparatus for applying written data (electronic signature) to a document created, stored, and displayed in electronic (HTML and e-mail) format (column 5, lines 55-67)(Fig. 3A), wherein the written data was captured in a first data format (columns 4 & 12, lines 66-67 & 15-27), then converted (displayed) into an electronic (HTML and e-mail) format and applying said written data in electronic (HTML and e-mail) format into said document (Fig. 3A).

-In regard to dependent claim 2, Smithies et al teach said written data was captured in an image file format (columns 4 & 12, lines 66-67 & 15-27)

-In regard to dependent claim 3, Smithies et al teach the written data was created and captured using a pen-based input strip (column 4, lines 5-7 & 20-25).

-In regard to dependent claim 4, Smithies et al teach attaching a link (columns 4 & 5, lines 20-24 & 55-67) into a software package for creating and transmitting documents in electronic (HTML and e-mail) (Fig. 3A) format (Abstract).

-In regard to dependent claim 7, Smithies et al teach creating an encryptive code number associated with the written data (columns 4 & 5, lines 62-67 & 1-4).

-In regard to dependent claim 8, Smithies et al teach wherein said encryptive code permitted data to display the date and time when the handwritten data was added to the document (column 4, lines 63-64), to display an indication as to whether or not the document had been changed since the signature was added (document checksum)(column 4, lines 45-50 & 65), and to allow a comparison of the key characteristics of the signature with a signature previously received from the same sender (column 5, lines 24-48).



***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithies et al (US: 6,381,344 04/30/02) in view of Apfel et al (US: 6,510,453 01/21/03).

-In regard to dependent claim 5, Smithies et al teach wherein said automatic link (column 4, lines 20-24) creates an additional option (Fig. 3A: 20) which when selected retrieves the written data in image file format (columns 4 & 12, lines 66-67 & 15-27), converts the data to electronic (HTML and e-mail)(column 5, lines 55-67)(Fig. 3A) format, and adds the written data to the electronic (HTML and e-mail) document (Fig. 3A). Smithies et al do not teach wherein the written data was added at a user defined position. Apfel et al teach wherein electronic e-mail signatures can be inserted into electronic e-mails in a user defined predetermined locations based on beginning and ending delimiters of a data field (columns 14 & 15, lines 64-67 & 1-4). It would have been obvious to one of ordinary skill in the art at the time of the invention, for Smithies et al to have allowed user defined locations of their signatures as shown in Apfel et al, because Smithies et al teach that there are multiple types of forms and applications to add written signature data to (columns 3 & 5, lines 10-27 & 62), and it would have been obvious to one of ordinary skill in the art that each of the multiple forms would require a different positioning of the

Art Unit: 2178

written data specific to that form (i.e. A user may not want to read down 30 pages of a lengthy legal document to see if it was signed/authentic so the written signature should be at or near the beginning, supposed to most email messages which like letters traditionally position the personalization of the signature at or near the end).

-In regard to dependent claim 6, Smithies et al teach wherein the hand written data to be created and captured (column 4, lines 20-45) when the link was selected and then (after clicking "OK")(Fig. 3A) automatically converting it to electronic (HTML and e-mail) format by adding it to the electronic (HTML and e-mail) document (column 5, lines 55-67)(Fig. 3A).

Art Unit: 2178

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US: 6,178,426

01/23/01

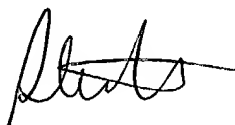
Klein et al.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L Basehoar whose telephone number is (703) 305-7212. The examiner can normally be reached on M-F: 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB

  
STEPHEN S. HONG  
PRIMARY EXAMINER